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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/561,120 | 11/13/2006 | Milton Flavio De Macedo | 995,1031 | 1810 |
| 54042 | 7590 | 04/02/2009 | | |
| WOLF, BLOCK, SHORR AND SOLIS-COHEN LLP | | | EXAMINER | |
| 250 PARK AVENUE | | | WILSON, BRIAN P | |
| 10TH FLOOR | | | ART UNIT | PAPER NUMBER |
| NEW YORK, NY 10177 | | | 2612 | |
| | | NOTIFICATION DATE | DELIVERY MODE | |
| | | 04/02/2009 | ELECTRONIC | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO@WOLFBLOCK.COM
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| | | |
|------------------------------|--------------------------------------|---|
| Office Action Summary | Application No. 10/561,120 | Applicant(s) DE MACEDO, MILTON FLAVIO |
| | Examiner Brian Wilson | Art Unit 2612 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 11/13/2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-4 is/are allowed.
- 6) Claim(s) 5-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 December 2005 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/146/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/15/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Status

1. Claims 1-19 are currently pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-6 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 5, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 6 is also rendered indefinite because it is dependent from claim 5.

Claim 11 recites the limitation "*the edge*" in claim 11. There is insufficient antecedent basis for this limitation in the claim.

Claims 12-14 are also rendered indefinite because they are dependent from claim 11.

Claim 12 recites the limitations "*the interior side*" and "*the exterior side*" in claim 12. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7, 9, 15, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Serrault (U.S. Patent 6,191,691).

Regarding claim 7, Serrault discloses an electronic device met by (Fig. 8; 6); a film coating electronic device met by (Col. 3, lines 29-33; note, protected by an insulating material); a capsule met by (Fig. 2; 7, 8), a base portion met by (Fig. 2; 7), and a top portion met by (Fig. 2; 8), interlocking met by (Fig. 5; 16 & Fig. 6, 17).

Regarding claim 9, the claim is interpreted and rejected as claim 7.

Regarding claim 15, Serrault further discloses capsule is structured and arranged so the electronic device fits snugly between top portion and base portion met by (Fig. 2; 6 & Fig. 5; 14 & Fig. 6; 20; note, the transponder appears to fit snugly between 14, and 20 and isn't vibrating).

Regarding claim 18, Serrault further discloses capsule is formed of a material that does not interfere with electromagnetic waves met by (Col. 4, lines 4-5; note, transponder can not send/receive if the plastic blocks RF signals), and is strong met by (capsule has a rigid design to resist forces from the slamming of the container lid).

Regarding claim 19, Serrault further discloses capsule is formed from a polycarbonate met by (Col. 4, lines 4-5; note, polycarbonates are thermoplastic polymers), relative flexibility met by (this is a benefit of using polycarbonates).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serrault (U.S. Patent 6,191,691) in view of Applicant's Background.

Regarding claim 8, Serrault discloses a receive-sender delimiter met by (Fig. 8; 6).

However, Serrault does not disclose for *pneumatics*.

Applicant's Background teaches a *pneumatics* met by ([0007]). It is obvious to use transponders inside tires.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Applicant's Background transponder into Serrault. This provides a convenient way to send/receive temperature and pressure information from inside tires.

Regarding claim 10, Serrault discloses a transponder. However, Serrault does not specifically disclose a *chip and coil reel*.

Applicant's Background teaches a *chip and coil reel* met by ([0002]). It is obvious to use a chip and coil reel in designing transponders.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Applicant's Background chip and coil reel into Serrault. This provides a simple and robust design for transponders.

8. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Serrault (U.S. Patent 6,191,691) in view of Hardman (U.S. Pub 2002/0075145).

Regarding claim 11, Serrault discloses a base portion, top portion, cover portion met by (Fig. 7; 20), and attachment wall met by (Fig. 7; 17). However, Serrault does not disclose *a platform, a ring wall around platform, a side wall around the edge of base portion, and attachment wall structured and arranged to fit snugly between ring wall and side wall of base portion.*

Hardman teaches a *platform* met by (Fig. 5B; 15), a *ring wall around platform* met by (Fig. 5E; 39C), a *side wall around the edge of the base portion* met by (Fig. 5E; 39B), and *attachment wall structured and arranged to fit snugly between ring wall and side wall of base portion* met by (Fig. 5E; 14B). It is obvious to design interlocking top and base covers to house a transponder.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Hardman's design features into Serrault. This provides transponder housing covers that are easily connectable, and protects the transponder from damage.

Regarding claim 12, the claim is interpreted and rejected as claim 11.

Regarding claim 13, the claim is interpreted and rejected as claim 11.

Regarding claim 14, the claim is interpreted and rejected as claim 11.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serrault (U.S. Patent 6,191,691) in view of Nishimura (U.S. Patent 5,958,648).

Regarding claim 16, Serrault discloses a film met by (Col. 3, lines 32-35; note, protective varnish, and this varnish does not interfere with the functionality of the transponder). However, Serrault does not disclose *prevents electronic device from being damaged by chemicals*.

Nishimura teaches *prevents electronic device from being damaged by chemicals met by* (Col. 2, lines 15-22; note, chemical resistance). It is obvious to design a protective film for use on a PCB or IC that protects the circuitry from chemicals.

Nishimura does not teach protection from acids. It is obvious that many chemicals are acidic, and PCBs and ICs need protection from chemicals that are acidic.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Nishimura's protective film properties into Serrault. This provides a protective coating that is very versatile, and can ensure the functionality of the integrated circuit.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serrault (U.S. Patent 6,191,691) in view of Koduri (U.S. Patent 6,734,532).

Regarding claim 17, Serrault discloses a protective varnish. However, Serrault does not disclose the *film is plastic*.

Koduri teaches the *film is plastic* met by (Col. 4, lines 28-30). It is obvious to use a plastic film to protect a chip surface.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Koduri's plastic film into Serrault. This provides a protective coating that can ensure the functionality of the chip.

Allowable Subject Matter

11. Claims 1-4 allowed.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Koch (U.S. Patent 7,331,367) discloses a monitoring device and patch assembly.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Wilson whose telephone number is (571)270-5884. The examiner can normally be reached on Monday-Thursday from 8-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571)272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BPW/

/Daniel Wu/
Supervisory Patent Examiner, Art Unit 2612